

REMARKS/ARGUMENTS

Claims 68-76 were pending in the present application. By virtue of this response, claims 68-71 have been amended, which have support throughout the specification. Accordingly, claims 68-76 are currently under consideration. Applicant respectfully requests an Examiner interview to discuss the substance of this response at the Examiner's convenience.

Claim Rejections under 35 U.S.C. §112

Claims 68-76

In the Office Action, the Patent Office rejected Claims 68-76 under §112, first paragraph, as failing to comply with the written description requirement. The Examiner states that "Claim 68 recites the limitation 'detection mechanism configured to *measure*', emphasis added, which is considered new matter." Further, the Examiner states that "Applicant's 'detection mechanism' appears to be imaging devices such as radiography, ultrasonography, magnetic resonance imaging, etc, which *detect* or *display* an image, however does [*sic*] not appear to measure parameters." The following amendment to Claim 68 is sufficient to overcome the §112 rejection. And the amended Claim 68 satisfies the requirements of §112, first paragraph. Moreover, Claims 69-76 depend from Claim 68. These claims are further believed allowable for the same reasons set forth with respect to their parent Claim 68.

Claim Objection

In the Office Action, the Patent Office objected to Claim 70 for lack of a period. The following amendment to Claim 70 has overcome this objection. The Applicant respectfully requests the Examiner to withdraw the objection.

Claim Rejections under 35 U.S.C. §102

Claims 68-72 and 74

Claim 68 includes a "plurality of structural elements being composed of a first material, at least one region of the plurality of structural elements being composed of a second material, the second material having at least one of a second transition temperature and a second transition coefficient." The Examiner alleges that *Santini, Jr. et al.* disclose these elements in P0030, P0046, and P0048 because, according to the Examiner, *Santini, Jr. et al.* teach "different microchip caps made of different materials with different transitional temperatures or deform at

different rates.” The Examiner mischaracterizes P0030, P0046, and P0048 of *Santini, Jr. et al.* and consequently *Santini, Jr. et al.* does not disclose all elements of Claim 68.

Santini, Jr. et al. describe an implantable medical device having reservoirs containing medicine for release into the bloodstream. These reservoirs are sealed by caps which can disintegrate or are selectively permeable such that they release the medicine of the reservoirs into the bloodstream (see P0030). *Santini, Jr. et al.* disclose that the caps can be made from different layers of material (see P0030 and FIG. 4d). *Santini, Jr. et al.* also disclose that individual caps may have different melting temperatures (see P0046 and P0048). However, nowhere do *Santini, Jr. et al.* disclose that individual caps may have different transition temperatures. A melting temperature is a temperature at which a material changes from a solid to a liquid. A transition temperature is a temperature at which a material changes from one solid-state phase (e.g. martensite) into another solid-state phase (e.g. austenite). Merely because different materials have different melting temperatures does not imply that any of the single materials have different transition temperatures.

Furthermore, in addition to having different “transition temperatures,” the structural elements of Claim 68 may have different “transition coefficients.” According to page 19, lines 13-16 of Applicant’s specification, a “transition coefficient” describes how a material deforms in response to an applied force. Therefore, a structural element with a first “transition coefficient” may change its “geometry” or “conformation” upon application of a certain magnitude force while a structural element with a second “transition coefficient” may not change its “geometry” or “conformation.” Nowhere do *Santini, Jr. et al.* disclose individual caps made from materials with different “transition coefficients” such that only certain caps deform upon application of a force to all the caps.

In conclusion, *Santini, Jr. et al.* do not disclose caps having different “transition temperatures” or “transition coefficients.” Since *Santini, Jr. et al.* fail to disclose each and every element specifically defined in Claim 68, the rejection of Claim 68 under §102(e) has been overcome and should be withdrawn. Moreover, Claims 69-72 and 74 depend from Claim 68. These claims are further believed allowable over *Santini, Jr. et al.* for the same reasons set forth with respect to their parent Claim 68 since each sets forth additional elements of Applicant’s device.

Alternatively, *Santini, Jr. et al.* fail to disclose each and every element specifically defined in amended Claim 68, the rejection of Claim 68 under §102(e) has been overcome and should be withdrawn. Moreover, Claims 69-72 and 74 depend from amended Claim 68. These claims are further believed allowable over *Santini, Jr. et al.* for the same reasons set forth with respect to their parent Claim 68 since each sets forth additional elements of Applicant's device.

Santini, Jr. et al. describe an implantable medical device having reservoirs containing medicine for release into the bloodstream. These reservoirs are sealed by caps which can disintegrate or are selectively permeable such that they release the medicine of the reservoirs into the bloodstream (*see* P0030). *Santini, Jr. et al.* also disclose that individual caps may have different melting temperatures (*see* P0046 and P0048). In a molten state, the "cap is then mobile, which facilitates the opening of the reservoir and release of [medicine]." P0046. This description of how the geometry of a cap changes during melting demonstrates that, if the cap later hardens, it will have an amorphous shape dissimilar to its original shape. Therefore, returning the cap to its original shape will be impossible by simply altering the temperature conditions. Furthermore, *Santini, Jr. et al.* describe the cap as undergoing "degradation" during melting. This implies that the cap is disintegrating and being released into the blood stream when it is in a molten state. Thus, when a cap re-hardens, it will have a mass that is less than its original mass.

The structural elements of Claim 68 "changes from the second geometry to the first geometry upon removal of the at least one of internal force and external force", unlike the caps of *Santini, Jr. et al.* Furthermore, unlike the caps of *Santini, Jr. et al.*, the structural elements will not lose mass due to changes in temperature conditions. The following amendment to Claim 68 reflects these characteristics of Applicant's device and renders Claim 86 novel in light of *Santini, Jr. et al.*

Claim Rejections under 35 U.S.C. §103

Claims 68-75

In the Office Action, the Patent Office rejected Claims 68-75 under 35 U.S.C. §103(a) as being unpatentable over *Burmeister* (EP 0 759 730 B1) in view of *Wolinsky et al.* (U.S. Pat. No. 6,840,956). In regards to Claim 68, the Examiner alleges that *Wolinsky et al.* discloses the "detection mechanism" of Claim 68 while *Burmeister* discloses the remainder of Claim 68's elements. The Applicants respectfully disagree.

Since *Burmeister* and *Wolinsky et al.* fail to disclose each and every element specifically defined in amended Claim 68, the rejection of Claim 68 under §103(a) has been overcome and should be withdrawn. Moreover, Claims 69-76 depend from amended Claim 68. These claims are further believed allowable over *Burmeister* and *Wolinsky et al.* for the same reasons set forth with respect to their parent Claim 68 since each sets forth additional elements of Applicant's device.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and pass this application to issue. The Applicant respectfully requests a telephone conference to expedite the prosecution of the application, the Examiner is invited to telephone the undersigned at the number provided below at the earliest convenience.

Any remarks in support of patentability of one claim should not be imputed to any claim, even if similar terminology is used. Additionally, any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. Applicants respectfully traverse each of the Examiner's rejections and each of the Examiner's assertion regarding what the prior art shows or teaches, even if not expressly discussed herein. Although amendments have been made, no acquiescence or estoppel is or should be implied thereby. Rather, the amendments are made only to expedite prosecution of the present application, and without prejudice to presentation or assertion, in the future, of claims on the subject matter affected thereby.

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child, or related prosecution history shall not

reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

No fee is believed due with the filing of this document. However, in the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 18-2000, of which the undersigned is an authorized signatory.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. Peter Paredes', written in a cursive style.

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